

### **REMARKS**

The applicants have carefully considered the Office action dated December 2, 2004 and the references it cites. By way of this response, claims 22 and 23 have been broadened. In view of the following, it is respectfully submitted that all pending claims are in condition for allowance and favorable reconsideration is respectfully requested.

#### **The 35 U.S.C. § 112 Rejections**

The Office action rejected claims 14, 19, 22 and 23 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The applicants respectfully traverse these rejections.

The Office action asserts that claims 19, 22, and 23 are not enabled because “[t]he disclosure does not describe how and in what manner the breechblock and/or recoil movement of the breechblock opens the dust cover.” However, it has long been established that “a patent need not teach, and preferably omits, what is well known in the art.” Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. 81 (Fed. Cir. 1986), see also, M.P.E.P. § 2164.01. Firearms have long used dust covers that open in response to the motion of a breech. Indeed, the structure and interaction of a breech and a dust cover have been known to persons of ordinary skill in the art for more than 50 years. Given this widespread knowledge, it was unnecessary and, indeed, preferable under the law as enunciated by the Federal Circuit above, to omit the details of the interaction of the breech and the dust cover.

The fact that the interaction of the dust cover and the breech was well known to persons of ordinary skill in the art prior to the filing of this application is

demonstrated by Technical Manual No. 9-1005-249-12, Dept. of the Army, August 1968 (copy enclosed), which indicates that basic issue weapons of the United States Army had dust covers which were opened by movement of the breech as early as the 1960s. Furthermore, U.S. Pat. No. 6,523,293 describes how movement of a bolt assembly can be used to open a dust flap. (See col. 3 ll. 59-62). In view of the foregoing, a person of ordinary skill in the art reading applicants' specification would have no trouble understanding how the movement of the breech opens the dust cover, and it is unnecessary to include the specifics of this motion in the specification because "[a] patent need not teach, and preferably omits, what is well known in the art." M.P.E.P. § 2164.01. Consequently, it is respectfully submitted that the 35 U.S.C. § 112, first paragraph, rejections of claims 19, 22, and 23 must be withdrawn.

Turning to the § 112 rejection of claim 14, the Office action states that "the disclosure does not describe ... how the pins having different magnetic fields affect the closing/opening of the dust cover." However, the United States Supreme Court established long ago that a patent need not describe the underlying scientific principles of operation:

The law has other tests of invention than subtle conjecture of what might have been seen and yet was not. It regards a change as evidence of novelty, and the acceptance and utility of change as further evidence, even as demonstration. Nor does it detract from its merit that it is the result of experiment and not the instant and perfect product of inventive power. A patentee may be baldly empirical, seeing nothing beyond his experiments and the result; yet, if he has added a new and valuable article to the world's utilities, he is entitled to the rank and protection of an inventor. ***It is certainly not necessary that he understand or be able to state the scientific principles underlying his invention***, and it is immaterial whether he can stand

a successful examination as to the speculative ideas involved.

Diamond Rubber Co. v. Consolidated Rubber Tire Co., 220 U.S. 428, 435

(1911)(emphasis added). Thus, the underlying scientific principles as to “how the pins having different magnetic fields affect the closing/opening of the dust cover,” were not required to be included in the specification.

Applicants’ specification clearly explains how to utilize the magnetic pins 15 in paragraph [0025] of the specification. A person of ordinary skill in the art would have no trouble following those teachings. The law requires nothing more. Thus, the invention of claim 14 is fully enabled and the 35 U.S.C. § 112, first paragraph, rejection of claim 14 must be withdrawn.

### **The Drawings Objections**

The drawings have been amended to address the objections to claims 7, 12, 13, 20 and 21. No new matter has been introduced.

### **The 35 U.S.C. § 103 Rejections**

Turning to the rejections on the art, the Office action rejected all pending claims as being unpatentable over Murello, U.S. Patent 6,523,293 (which is commonly assigned to Heckler & Koch, GmbH, the owner of this application), when viewed in combination with Swink, U.S. Patent 4,753,495, and/or Su, U.S. Patent 6,550,298. The applicants respectfully traverse these rejections.

For example, independent claim 1 recites a firearm including a dust cover and a magnetic lock to secure the dust cover in the closed position. The

Office action states that Murello contains all the elements of claims 1 except a magnetic lock, but that it would be obvious to add such a lock to Murello in view of Swink, which employs a magnetic lock to secure a door of a cabinet in the closed position. This position is in error for numerous reasons.

First, the Swink reference is not analogous art to the inventions recited in claim 1. "A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." In re Clay, 966 F.2d 656, 659 (Fed. Cir. 1992). Here, no reasonable inventor concerned with securing a dust cover to a firearm in a manner that would allow for the dust cover to open and close would ever have thought to look to the merchandise display cabinetry industry for a potential solution to the problem. A person of ordinary skill in the firearm art simply does not look to the furniture/cabinetry arts for teachings on how to construct a firearm. As such, an inventor faced with the problem of securing a dust cover to a firearm such that it can be opened upon, for example, the firing of a cartridge, would never have examined how the retail industry displays merchandise in cabinets that have doors as part of the search for a solution to his problem. Indeed, one would only look to Swink after learning of the idea of using a magnetic lock for the dust cover of a firearm from the instant application. Without the teaching of the applicants' own specification, one would never consider Swink in trying to create a latch for the dust cover of a firearm. In short, the Swink reference is

non-analogous art. The rejections based on Swink are, therefore, in error and must be withdrawn.

Secondly, it simply is not and was not obvious to anyone skilled in the art to combine the magnetic latch from a cabinet with the dust cover on a firearm. Dust covers have been used in firearms since at least 1942. Magnetic locks in appliances and cabinets such as that described in the Swink document have also been known for decades. Despite the availability of this knowledge for over fifty years, no person has combined these features to utilize a magnetic lock in a firearm.

One reason for this failure is that, as explained above, the furniture/cabinetry arts are not analogous to the firearm art. Another reason for this failure is that magnetic locks must be manufactured within relatively tight tolerances. If the magnetic lock components are not properly aligned, the magnetic force will be insufficient for holding the dust cover shut. Thus, the holding force of the magnetic lock must be large to ensure that, even in the case of misalignment, the lock will function. As a result, the breech must apply a significant force to overcome the magnetic lock and open the dust cover. The requirement of such a force raises the possibility of a breech jam, particularly in the case of lower caliber weapons. As a result of these constraints, a person of ordinary skill in the art would not find it obvious to utilize a magnetic lock to secure a dust cover of a firearm.

In view of the foregoing, it is clear that no prior art reference(s) of record teach or suggest the application of a magnetic lock to the dust cover of a firearm. As such, there is no evidence of record of any suggestion to

combine the magnetic lock from Swink or any other prior art appliance/cabinet with the dust cover of Murello. On the contrary, the only evidence of record demonstrates that it was not obvious to make such a combination.

Before leaving this point, the Office is reminded that the mere fact that dust covers and magnetic locks are in and of themselves old elements is immaterial to whether or not their combination in a firearm is patentable. As explained by the Federal Circuit:

As this court has stated, ***“virtually all [inventions] are combinations of old elements.”***

Therefore, an examiner may often find every element of a claimed invention in the prior art.

***If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue.***

Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to **show** a motivation to combine the references that create the case of obviousness.

In re Rouffet, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998)(citations omitted and emphasis added). Thus, the mere facts that the Office is able to find magnetic locks in prior art appliances and dust covers in prior art firearms does *not* preclude patentability of the combination of a dust cover and a magnetic lock in a firearm. Simply put, the Office must provide *evidence* of a suggestion *in the prior art* for combining a dust cover with a magnetic lock in

a firearm to reject claim 1. In the absence of evidence of such a suggestion, claim 1 is patentable.

To clarify this point, the Office is respectfully reminded that an obviousness rejection must be based on facts, not conjecture.

The Supreme Court... foreclosed the use of substitutes for facts in determining obviousness under section 103. The legal conclusion of obviousness *must be supported by facts*. Where the legal conclusion is not supported by facts it cannot stand.

In re Warner, 379 F.2d 1011, 1017 (C.C.P.A. 1967). In the present case, the record is devoid of any evidence that it would be obvious to utilize a magnetic lock on a dust cover of a firearm. On the contrary, the evidence of record demonstrates that persons of ordinary skill in the art have failed to create such a combination despite the widespread knowledge of magnetic locks in cabinetry/furniture, and of dust covers in firearms for more than 50 years. Accordingly, on the present record, claim 1 and all claims depending therefrom must be allowed over Murello and Swink.

Before closing, the applicants note that the Su reference does not overcome the deficiencies of the Murello/Swink combination, and, thus, does not change any of the foregoing analysis. Su describes “a lockset assembly having a keyway cover-up mechanism to prevent entry of dust or other foreign matter into the keyway.” (Su at Col. 1, lines 7-9). While it is clear why Su would appear in, for example, a computerized keyword search directed toward the elements of claim 1 in that Su clearly uses the word “dust” and is directed to a lock, Su has nothing to do with firearms or dust covers for firearms. Further, it provides absolutely no suggestion for utilizing a magnetic lock to

secure a dust cover in a firearm. Thus, irrespective of how one combines Murello, Swink and Su, one does not arrive at the combination of claim 1. Consequently, claim 1 and all claims depending therefrom should be allowed.

Independent claims 22 and 23 are also allowable. Among other things, claim 22 recites “securing the dust cover in the closed position with a magnetic lock.” As discussed in detail above, none of Murello, Swink or Su provide any teaching or suggestion for securing a dust cover of a firearm with a magnetic lock. Consequently, claim 22 is allowable over the cited art.

Independent claim 23 recites, among other things, “using at least one magnetic field to attract the dust cover to the housing such that the dust cover is locked in the closed position.” As discussed above, none of Murello, Swink or Su provide any teaching or suggestion for locking a dust cover of a firearm with a magnetic field. Consequently, claim 23 is allowable over the cited art.

Before closing, applicants note that the rejections of the dependent claims are all traversed for at least the reasons given above. In addition, applicants note that the Office action makes several incorrect and/or unsupported statements which the applicants specifically traverse.

For example, on page 5, the Office action states, “it would have been obvious to have the magnetic strip embedded/crimped in the dust cover or housing since it has been held that any method of attaching or installing a magnetic strip or joining together is well known in the art.” The applicants respectfully traverse this statement. The Office cites no authority for the blanket proposition that all possible methods of attaching or installing a magnetic strip or joining together are well known. Moreover, it is highly



unlikely that any court of law would proclaim that there can be no future inventions relating to any possible method of attaching or installing a magnetic strip or joining together, or, indeed, that *anyone* has the foresight to safely proclaim that there will never be any new method of “attaching or installing a magnetic strip or joining together” in the future. As such, this unsupported proclamation is speculative and improper. If the Office is actually referencing a real authority for this proposition, the applicants respectfully request that the Office identify that authority in the next Office action. If there is no authority for this proposition, the Office must withdraw it and the rejections upon which it is based.

On page 5, the Office action also states, “Further the location of the magnetic strip or pins on the dust cover or housing is obvious since installing the magnetic device at any location solves any stated problem or is fro [sic] any particular purpose and it appears the invention would perform equally well with the pins or strips placed anywhere on the housing or dust cover which is to close and open the dust cover.” Applicants respectfully traverse this statement as inaccurate and inappropriate. First, the quoted statement indicates that the recitations are being held as obvious because they would “solve any stated problem” or be for “a particular purpose.” Applicants are at a loss to understand this position. Clearly, the Office cannot be indicating that only claims that include recitations that do not solve a problem and do not serve a purpose are patentable? Such a position would mean, of course, that only absolutely useless things are patentable!

Second, as explained above, the Office may only reject claims based on *actual evidence*. Speculative statements about what might or might not happen by moving parts of the claimed structure to other positions has no place in the inquiry. If there is no evidence that meets the recitations of the claims, the applicants are entitled to a patent. Personal opinions play no role in this inquiry. Rather the patentability inquiry is to be an objective one, based on actual evidence, not a subjective one based on speculation and opinion. As such, the applicants respectfully traverse the above quoted statement as inaccurate, improper and irrelevant. The applicants respectfully request that the statement be withdrawn.

As a final matter, applicants note that the only amendments made in this response were to broaden the claims. As such, no claim amendment made in this response was necessary to overcome any grounds of rejection. Accordingly, if the next Office action is not an allowance, but instead includes a new ground of rejection, that new rejection cannot possibly have been necessitated by any action of the applicants. Consequently, any new Office action *cannot* properly be made final.

In view of the foregoing, it is respectfully submitted that all pending claims are in condition for allowance.

If the Examiner is of the opinion that a telephone conference would expedite the prosecution of this case, the Examiner is invited to contact the undersigned at the number identified below.

Respectfully submitted,

HANLEY, FLIGHT & ZIMMERMAN, LLC.  
Suite 4220  
20 North Wacker Drive  
Chicago, Illinois 60606  
(312) 680-1020

By:



James A. Flight  
Registration No. 37,622

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**In the Drawings:**

Please enter new Figures 2-3.